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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/719,554      | 01/18/2001  | Patrick M. Alliel    | 200936USPCT         | 1650             |

22850 7590 11/19/2002

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| EXAMINER |
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BROWN, STACY S

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| ART UNIT | PAPER NUMBER |
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1648

DATE MAILED: 11/19/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/719,554

Applicant(s)

ALLIEL ET AL.

Examiner

Stacy S Brown

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 October 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 1,2 and 4-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 1648

### **DETAILED ACTION**

1. Applicant's election with traverse of Group III (claim 3, SEQ ID NO: 3) is acknowledged and entered. It should be noted that the election of a single polynucleotide sequence is not an election of a species. The polynucleotide sequences are separate inventions because they have different sequences requiring separate sequence searches.

2. Claims 1-37 are pending. Claim 3 is examined on the merits. Claims 1-2 and 4-37 are withdrawn from consideration, being drawn to non-elected inventions.

### ***Priority***

3. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in France on June 23, 1998. It is noted, however, that applicant has not filed a certified copy of the 98 07920 application as required by 35 U.S.C. 119(b).

### ***Claim Objections***

4. Claim 3 is objected for referring to non-elected claim 1, and sequences 4-22, 28 and 61, also non-elected. Further, the claim should recite "polynucleotide fragment", since a nucleic acid fragment refers to only one nucleic acid.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 depends from non-elected claim 1, which itself is unclear. Claim 1 is drawn to a nucleic acid fragment having retroviral env-type motifs, corresponding to SEQ ID NO: 1, and various degrees of homology to SEQ ID NO: 1. The claimed sequence can be 80% identical to SEQ ID NO: 1 on more than 190 nucleotides, or 70% identical on more than 600 nucleotides.

- For sequences that have 80% identity to 190 nucleotides, or 70% identity to 600 nucleotides: Are the 190 and 600 nucleotides consecutive, or interspersed within SEQ ID NO: 1?
- Claim 3 refers to "preceding sequences", however it is unclear which of the sequences are the preceding ones.

Regarding claim 3, the phrase "in particular" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

*The examination of claim 3 is based on its broadest interpretation. The fragment referred to in claim 3 could be a single nucleotide, not necessarily from an endogenous retroviral sequences. Clarification is required for claim 3.*

#### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1648

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 3 is rejected under 35 U.S.C. 102(b) as being anticipated by Pauley and Waterson (see attachment from the Office Action dated August 5, 2002). Claim 3 is drawn to a nucleic acid fragment, comprising a segment of SEQ ID NO: 1. The claim also refers to SEQ ID NO: 3. Claim 3, as previously discussed in this Office Action, is unclear and encompasses a single nucleotide. A single nucleotide of SEQ ID NO: 3 is taught by Pauley and Waterson.

*Applicant is invited to amend the claims to recite the intended length of the isolated polynucleotide in order to properly identify and search Applicant's novelty.*

### **Conclusion**

7. No claim is allowed.

Papers relating to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 located in Crystal Mall 1. The Fax number for Art Unit 1648 is (703) 308-4426. All Group 1600 Fax machines will be available to receive transmissions 24 hrs/day, 7 days/wk. Please note that the faxing of such papers must conform with the Notice published in the Official Gazette, 1096 OG 30, (November 15, 1989).

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Stacy S. Brown, whose telephone number is (703) 308-2361. The Examiner can normally be reached on Monday through Friday and alternate Wednesdays from 6:30 AM-4:00 PM, (EST). If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, James C. Housel, can be reached at (703) 308-4027. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*Stacy S. Brown*

Stacy S. Brown  
November 18, 2002

*James C. Housel*  
JAMES HOUSEL 11/18/02  
SUPERVISORY PATENT EXAMINER  
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